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10/784,179	02/24/2004	Koji Ishizaki	BD0401T	1144

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TAKEUCHI & KUBOTERA, LLP  
SUITE 202  
200 DAINGERFIELD ROAD  
ALEXANDRIA, VA 22314

EXAMINER
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DICKER, DENNIS T

ART UNIT	PAPER NUMBER
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2625

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/784,179

**Applicant(s)**

ISHIZAKI, KOJI

**Examiner**

Dennis Dicker

**Art Unit**

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Gillihan et al (hereinafter "Gillihan '262" 6,842,262).
3. As pertaining to **Claim 1** , Gillihan '262 teaches An image forming apparatus **(i.e., Col. 5 Lines 12-21 , A printer such as a multi function printer with a interface)** comprising: a data collecting section **(i.e., Col.3 Lines 25-26, Electronic document is received )** to reduce a plurality of pages of data **(i.e., Col. 4 Lines 46-48 , N-Up printing reduces an N number of pages)** and create collected data collected in a sheet of print medium **(i.e., Col. 4 Lines 46-48, n-up printing reduces an N number of pages to a sheet of print medium )**;  
  
a specific information **(i.e., Col. 4 Line 50, Watermark)** creating section to create specific information which is overlapped with said collected data and applied to said sheet of said print medium **(i.e., Col 4 Lines 49-50, watermark can be overlapped with selected pages in document)**; and a data editing section to overlap said specific information with said collected data **(i.e., Col 48-50, Data is edited by an Insertion of a watermark on selected pages)**

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2-5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gillihan '262 in view of Mori (hereinafter "Mori '179" 7,027,179)

With respect to **Claim 2**, Gillihan '262 does not teach an image forming apparatus which further comprises a setting section to set a parameter according to which said specific information is created.

However, the mentioned claimed limitations are well known in the art as evidenced by Mori '179. In particular, Mori '179 teaches the use an image forming apparatus which further comprises a setting section (**i.e., 17 of Fig. 3, Watermark setting**) to set a parameter (**i.e., 20 of Fig. 3, Text of Parameter may be set**) according to which said specific information is created (**i.e., Col. 5 Lines 6-10, Text will be created as watermark**)

In view of this, it would have been obvious to one having ordinary skill in the art at the time of invention was made to modify the image forming apparatus of Gillihan '262 as taught by Mori '179 since Mori '179 suggested in Col. 1 Line 66 - Col. 2 Line 4 that such a modification would permit an image forming apparatus to generate a print job in a simple reliable manner so that the device forms images with a plurality of different watermarks based on the print job.

With respect to **Claim 3**, Gillihan '262 does not teach an image forming apparatus wherein said setting section sets a character string of said specific information

However, the mentioned claimed limitations are well known in the art as evidenced by Mori '179, In particular, Mori '179 teaches the use of an image forming apparatus wherein said setting section sets a character string (**i.e., Col 6 Lines 18-26, User sets desired text string of watermark**) of said specific information.

In view of this, it would have been obvious to one having ordinary skill in the art at the time of invention was made to modify the image forming apparatus of Gillihan '262 as taught by Mori '179 since Mori '179 suggested in Col. 1 Line 66 - Col. 2 Line 4 that such a modification would permit an image forming apparatus to generate a print job in a simple reliable manner so that an the device forms images with a plurality of different watermarks based on the print job.

With respect to **Claim 4**, Gillihan '262 does not teach an image forming apparatus wherein said setting section sets a position for overlapping said specific information with said collected data.

However, the mentioned claimed limitations are well known in the art as evidenced by Mori '179, In particular, Mori '179 teaches the use of an image forming apparatus wherein said setting section sets a position (**i.e., 13 of Fig. 3 and Col 6 Lines 40-43, Position section sets position of watermark**) for overlapping said specific information with said collected data (**i.e., Col 2 Lines 13-20, combining unit combines watermark and image data**).

In view of this, it would have been obvious to one having ordinary skill in the art at the time of invention was made to modify the image forming apparatus of Gillihan '262 as taught by Mori '179 since Mori '179 suggested in Col. 1 Line 66 - Col. 2 Line 4 that such a modification would permit an image forming apparatus to generate a print job in a simple reliable manner so that an the device forms images with a plurality of different watermarks based on the print job.

With respect to **Claim 5**, Gillihan '262 does not teach an image forming apparatus wherein said setting section sets a rotation angle when overlapping said specific information with said collected data.

However, the mentioned claimed limitations are well known in the art as evidenced by Mori '179, In particular, Mori '179 teaches the use of an image forming apparatus wherein said setting section sets a rotation angle (i.e., **Col 6 Line 40 ,Orientation angle of watermark may be set )** when overlapping said specific information with said collected data. (i.e., **Col 2 Lines 13-20, combining unit combines watermark and image data**).

In view of this, it would have been obvious to one having ordinary skill in the art at the time of invention was made to modify the image forming apparatus of Gillihan '262 as taught by Mori '179 since Mori '179 suggested in Col. 1 Line 66 - Col. 2 Line 4 that such a modification would permit an image forming apparatus to generate a print job in a simple reliable manner so that an the device forms images with a plurality of different watermarks based on the print job.

With respect to **Claim 8** Gillihan '262 does not teach an image forming apparatus wherein said specific information is data which corresponds to one of said plurality of pages.

However, the mentioned claimed limitations are well known in the art as evidenced by Mori '179. In particular, Mori '179 teaches the use of an image forming apparatus wherein said specific information is data which corresponds to one of said plurality of pages. (i.e., **Col. 6 Line 64-Col. 7 Line 9, user is able to select or edit a watermark which corresponds to a particular page**).

In view of this, it would have been obvious to one having ordinary skill in the art at the time of invention was made to modify the image forming apparatus of Gillihan '262 as taught by Mori '179 since Mori '179 suggested in Col. 1 Line 66 - Col. 2 Line 4 that such a modification would permit an image forming apparatus to generate a print job in a simple reliable manner so that the device forms images with a plurality of different watermarks based on the print job.

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gillihan '262 in view of Mori '179 and further in view of Reed et al. (hereinafter "Reed '996" 6,590,996)

With respect to **Claim 6**, the combination of Gillihan '262 and Mori '179 do not teach an image forming apparatus wherein said setting section sets a color of said specific information.

However, the mentioned claimed limitations are well known in the art as evidenced by Reed '996, In particular, Reed '996 teaches the use of an image forming apparatus wherein said setting section sets a color of said specific information (i.e., **Col 15 Lines 30-33, Color of watermark may be set**).

In view of this, it would have been obvious to one having ordinary skill in the art at the time of invention was made to modify the image forming apparatus of Gillihan '262 and Mori '179 as taught by Reed '996 since Reed '996 suggested in Col. 1 Lines 30-36 that such a modification would permit color masking of watermarks and make color components such that the change is less visible.

7. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gillihan '262 in view of Mori '179 and further in view of Hyakutake et al. (**hereinafter "Hyakutake '690" 7,142,690**)

With respect to **Claim 7**, the combination of Gillihan '262 and Mori '179 do not teach an image forming apparatus wherein said setting section sets a density of specific information.

However, the mentioned claimed limitations are well known in the art as evidenced by Hyakutake '690, In particular, Hyakutake '690 teaches the use of an image forming apparatus wherein said setting section sets a density of specific information (i.e., **Col. 16 Lines 22-34, setting section comprises an image density adjuster to set density of watermark**).

In view of this, it would have been obvious to one having ordinary skill in the art at the time of invention was made to modify the image forming apparatus of Gillihan



'262 and Mori '179 as taught by Hyakutake '690 since Hyakutake '690 suggested in **Col. 2 Lines 20-23** that such a modification would permit a method to manage the distribution of sensitive documents to unauthorized users.

8. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mori '179 Mori '179 and further in view of Lapstun et al (hereinafter "Lapstun '000" 6,728,000).

With respect to **Claim 9**, Mori '179 teaches an image forming apparatus (i.e., **Fig 1, Image forming apparatus**) comprising: an image creating section to create image data (i.e., **Col. 4 Lines 6-10, Application of Image forming apparatus creates image data**) ;

a specific information creating section (i.e., **Col. 4 Lines 21-24, watermark setting program**) to create specific information overlapped with said image data (i.e., **Col 4 Lines 38-43, Watermark setting program includes a watermark appending program for combining a watermark with the image data**); and a data transmitting section to output said specific information and said image data (i.e., **S8 of Fig. 4, image data and watermark data are sent to printer interface for output**).

Mori '179 does not explicitly teach a specific information inverting section to invert said specific information;

However, the mentioned claimed limitations are well known in the art as evidenced by Lapstun '000, In particular, Lapstun '000 teaches the use of inverting section (i.e., **Col. 34 Lines 46-47, dither matrix**) to invert said specific information (i.e., **Col. 34 Lines 47-53, Dither matrix is used to create inverted watermarks**).

In view of this, it would have been obvious to one having ordinary skill in the art at the time of invention was made to modify the image forming apparatus of Mori '179 as taught by Lapstun '000 since Lapstun '000 suggested in Col. 34 Lines 54-60 that such a modification would permit secure documents when photocopying.

9. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mori '179 in view of Lapstun '000 and further in view of Hernandez (hereinafter "Hernandez 428" 6,650,428).

With respect to **Claim 10**, the combination of Mori '179 and Lapstun '000 does not teach an image forming apparatus wherein said inverted specific information and said image data are created as data which are printed on front and back faces of a sheet of print medium, respectfully

However, the mentioned claimed limitations are well known in the art as evidenced by Hernandez 428, In particular, Hernandez 428, teaches the use of an image forming apparatus wherein said inverted specific information (**i.e., Col. 3 Line 60, Watermark information**) and said image data (**i.e., Col. 3 Line 62, Relevant material**) are created as data which are printed on front and back faces of a sheet of print medium, respectfully (**i.e., Col. 3 Line 59- Col 4 Line 2, Image data can be printed on one side while the watermark information another side of a print medium**).

In view of this, it would have been obvious to one having ordinary skill in the art at the time of invention was made to modify the image forming apparatus of Mori '179 and Lapstun '000 as taught by Hernandez 428 since Hernandez 428 suggested in Col. 1 Lines 35-38 that such a modification would permit a method for protecting confidential

information using standard paper and a method to distinguish between previously printed sides of multi page document and newly printed sides.

10. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mori '179 in view of Lapstun '000 and further in view of Gillihan '262.

With respect to **Claim 11**, the combination of Mori '179 and Lapstun '000 do not explicitly teach an image forming apparatus wherein said image creating section is capable of reducing a plurality of pages of data and creating collected data collected in said sheet of said print medium.

However, the mentioned claimed limitations are well known in the art as evidenced by Gillihan '262. In particular, Gillihan '262 teaches the use of an image forming apparatus wherein said image creating section (**i.e., Col. 3 Lines 25-30, Printing interface**) is capable of reducing a plurality of pages of data (**i.e., Col. 4 Lines 46-48 , N-Up printing reduces an N number of pages**) and creating collected data collected in said sheet of said print medium (**i.e., Col. 4 Lines 46-48, n-up printing reduces an N number of pages to a sheet of print medium );**.

In view of this, it would have been obvious to one having ordinary skill in the art at the time of invention was made to modify the image forming apparatus of Mori '179 and Lapstun '000 as taught by Gillihan '262 since Gillihan '262 suggested in Col. 3 Lines 14-18 that such a modification would permit a user to apply non-persistent formatting changes, useful in composing a printed output, to individual pages or groups of pages of an electronic document without altering the original electronic document.

11. Claim 12, 14 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Gillihan '262 in view of Davidson et al. (hereinafter "Davidson '485" 6,952,485).

With respect to **Claim 12**, Gillihan '262 teaches an image forming apparatus (**i.e., Col. 5 Lines 12-21 , A printer such as a multi function printer with a interface**) comprising: an image creating section to create image data (**i.e., Col. 4 Lines 16-18, Print driver creates image data to be printed out )** from document data (**i.e., Col. 4 Lines 16-18 , image data to be printed out is created from data sent from application**) a data transmitting section to output said specific information and said image data (**i.e., 14 of Fig. 3 and Col. 4 Lines 27-29, Formatting changes such as specific information are applied to image data to be outputted**) and said specific information being overlapped with said image data (**i.e., Col 48-50, Data is edited by an Insertion of a watermark on selected pages )**

Gillihan '262 does not explicitly teach an image forming apparatus comprising a document information extracting section (**i.e., Col. 2 Line 30, Encoder Application**) to extract document information from said document data (**i.e., Col. 2 Lines 34-35 , Encoder application extracts data about a document and stores it as metadata ); a specific information creating section to create specific information (i.e., Col. 2 Lines 35-38, A watermark is created from another application)** from said document information extracted by said document information extracting section (**i.e., Col. 2 Lines 35-38 , Metadata about document is extracted and included in watermark )**,

However, the mentioned claimed limitations are well known in the art as evidenced by Davidson '485, In particular, Davidson '485 teaches the use of an image

forming apparatus comprising a document information extracting section to extract document information from said document data; a specific information creating section to create specific information from said document information extracted by said document information extracting section, said specific information being overlapped with said image data.

In view of this, it would have been obvious to one having ordinary skill in the art at the time of invention was made to modify the image forming apparatus of Davidson '485 as taught by Davidson '485 since Davidson '485 suggested in Col. 8 Lines 6-10 that such a modification would enable the watermark functionality to operate in a manner that is independent of the application program that utilized the driver to send or receive data from an imaging peripheral.

With respect to **Claim 14**, Gillihan '262 teaches an image forming apparatus wherein said image creating section (i.e., **18 of Fig. 3, Printer Driver**) is capable of reducing a plurality of pages of data (i.e., **Col. 4 Lines 46-48 , N-Up printing reduces an N number of pages**) and creating collected data collected in said sheet of said print medium (i.e., **Col. 4 Lines 46-48, n-up printing reduces an N number of pages to a sheet of print medium** ).

With respect to **Claim 16**, Gillihan '262 does not explicitly teach an image forming apparatus wherein said document information is data which can identify a printing person.

However, the mentioned claimed limitations are well known in the art as evidenced by Davidson '485, In particular, Davidson '485 teaches the use of an image

forming apparatus wherein said document information (**i.e., Col. 2 Line 36 , Metadata )** is data which can identify a printing person (**i.e., Col. 2 Lines 30-38, Metadata includes user information**).

In view of this, it would have been obvious to one having ordinary skill in the art at the time of invention was made to modify the image forming apparatus of Davidson '485 as taught by Davidson '485 since Davidson '485 suggested in Col. 8 Lines 6-10 that such a modification would enable the watermark functionality to operate in a manner that is independent of the application program that utilized the driver to send or receive data from an imaging peripheral.

12. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gillihan '262 in view of Davidson '485 and further in view of Hernandez '428.

With respect to **Claim 13**, the combination of Gillihan '262 and Davidson '485 do not teach an image forming apparatus a wherein said extracted specific information and said image data are created as data which are printed on front and back faces of a print medium, respectfully.

However, the mentioned claimed limitations are well known in the art as evidenced by Hernandez 428, In particular, Hernandez 428, teaches the use of an image forming apparatus a wherein said specific information (**i.e., Col. 3 Line 60, Watermark information**) and said image data (**i.e., Col. 3 Line 62, Relevant material**) are created as data which are printed on front and back faces of a print medium, respectfully (**i.e., Col. 3 Line 59-Col 4 Line 2, Image data can be printed on one side while the watermark information another side of a print medium**).

In view of this, it would have been obvious to one having ordinary skill in the art at the time of invention was made to modify the image forming apparatus of Gillihan '262 and Davidson '485 as taught by Hernandez 428 since Hernandez 428 suggested in Col. 1 Lines 35-38 that such a modification would permit a method for protecting confidential information using standard paper. and a method to distinguish between previously printed sides of multi page document and newly printed sides.

13. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gillihan '262 in view of Davidson '485 and further in view of Stefik et al (hereinafter "Stefik '557" 2001/00085557).

With respect to **Claim 15**, the combination of Gillihan '262 and Davidson '485 do not teach an image forming apparatus a wherein said document data has a specific symbol for extracting said document information.

However, the mentioned claimed limitations are well known in the art as evidenced by Stefik '557, In particular, Stefik '557 teaches the use of image forming apparatus a wherein said document data has a specific symbol (**i.e., Para 0006 , Fingerprint**) for extracting said document information. (**i.e., Para 0081, Fingerprint embedded in watermark marks the document to enable authorized usage**).

In view of this, it would have been obvious to one having ordinary skill in the art at the time of invention was made to modify the image forming apparatus of Gillihan '262 and Davidson '485 as taught by Stefik '557 since Stefik '557 suggested in Para 0014-0015 that such a modification would provide information associated with that copy

of the document and information relating to the rendering event, where the information will typically aid in deterring or preventing unauthorized copying of the rendered work.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Dicker whose telephone number is (571) 270-3140. The examiner can normally be reached on Monday -Friday 7:30 A.M. to 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Aung Moe can be reached on (571) 272-7314. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Application/Control Number:  
10/784,179  
Art Unit: 2625

Page 16

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11/28/2007



KING Y. POON  
SUPERVISORY PATENT EXAMINER